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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,855	06/20/2001	David Alexander Learmonth	AAT-12563	4106

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EXAMINER

FORD, JOHN M

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 09/18/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/8505

Applicant(s)

Leamouth

Examiner

JMFord

Group Art Unit

1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on June 20, 2001.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1--9 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1--9 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other Exhibit A

Office Action Summary

*Exhibit A*

*Lead to  
applicant*

U.S. DEPARTMENT OF COMMERCE  
OFFICIAL GAZETTE of the UNITED STATES PATENT OFFICE

September 10, 1968

Volume 854

Number 2

PATENTS  
NOTICES

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**Dependent Claims**

The Notice on dependent claims of June 8, 1966 (828 O.G. 1) is modified as follows:

With particular reference to the second full paragraph, claims dependent on a genus which purport to be dependent but are in fact ultimate species do not qualify as true dependent claims. Exemplary of such claim forms are those which depend on a formula but which recite all variables in such manner that no further specificity is possible as well as those claims which name a specific compound and add, "according to claim 1" which is superfluous as far as the claim content is concerned. In summary, claims to ultimate species are not considered dependent claims. Although accepted for filing, claims of this type will be objected to and not acted on unless made independent by amendment and supported by the appropriate fee.

Aug. 19, 1968.

RICHARD A. WAHL,  
*Assistant Commissioner.*

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The claims in the application are claims 1--9.

There is no antecedent basis in claim 1 for claim 2.

The last few lines of claim 1 indicates A signifies alkylidene when R4 is OR8. R4 is never said to be OR8.

Claims 1 and 2 are unclear; 35 U.S.C. 112, 2nd paragraph.

Claim 3 is a list of specific compounds in one big run-on sentence. The heterocyclic compounds have no antecedent basis in claim 1, 37 CFR 1.141 provides for a reasonable number of species, Claim 3 is not a reasonable number of species.

See the directive of Commissioner Wahl, enclosed. The present claim structure of claim 3 is not acceptable.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

A method of <sup>↑</sup>treating some central or peripheral nervous system disorders is not specific enough to meet the Utility Guidelines. The use of "such as" in a claim is not acceptable; Ex parte Cordova, 10 U.S.P.Q. 2nd 1949. Claim 4 is rejected under 35 U.S.C. 112, 1st paragraph, Parkinson disease has no established regime of treatment.

All mood disorders is too broadly stated. Seasonal effective disorders are included therein. Light effective disorders are included. Gastrointestinal disturbances has many causes stress, acid meal, contaminated food.

MPEP 806.05(h) provides for restriction to one specific use.

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The uses here are not specific. Reduction in the O-methylation of catechol amines is a laboratory screen test.

The recent utility guideline set by PTO require applicants to meet the requirements as stated in *Brenner v. Manson* in, 148 USPQ 689, which requires that utility be developed to a point where “specific benefits exist in currently available form”. Similar is the “immediate benefit to the public” standard that *Nelson v. Bowler*, 206 USPQ 880 refers to. The standard set forth in the concurring opinion of *In re Hartop*, 135 USPQ 419 is “whether the invention has been brought to such perfection as to be capable of practice employment”. This language is echoed in *Bindra vs. Kelly*, 206 USPQ 570.

MPEP 806.05 (h) provides for restriction. A broad disclosure of utility, as in the cited claims, cannot be deemed in compliance with 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph. The treatment of hypertension -- is suggested. The PTO has amended the guidelines to clarify “specific utility”.

The court focused on the fact that the applicant failed<sup>to</sup> identify a “specific utility” in *Brenner v. Manson*.

This requirement of one specific utility, is consistent with Unity of Invention Practice in International Applications and National Phase Applications under 35 U.S.C. 371, and PCT Rule 13.2 for PCT applications.

Therefore, applicants should rewrite claim 4 to a “specific utility”.

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Claim 3 is rejected as failing to comply with 37 CFR 1.141(a). Claim 3 is more than a reasonable number of species. Claim 3 is a list of ultimate species. Applicants paid \$18.00 for claim 3. It costs \$45.00 to search each species on CAS-on-line. Each species of claim 3 has to be searched separately. The USPTO is losing money on claim 3. There is no generic concept. Each species has to be separately written out, and input, into the CAS-ON-LINE search system separately.

Claim 3 is a list of ultimate species to avoid fees. See, the memo of Richard A. Wahl, Exhibit A.

Claim 3 is rejected as it is an aggravated example of abuse of the Rules. Claim 3 is not a reasonable number of species.

In re Fressola, 22 USPQ 2nd 1828, indicates that the Examiner may reject for applicants failure to follow a Rule, see the last Office Action. Claim 3 in an Aggravated example of ultimate species listed in a claim, as it to avoid fees. Claim 3 is not a Markush claim. Claim 3 is a list of ultimate species. 37 CFR 1.141(a) provides for a reasonable number of species to be examined with the genus. Claim 1 is the genus, not claim 3. Claim 3 is an aggravated example of ultimate species, each of which has to be drawn out, and classified, and searched, I cannot tell if it is patentable or not. Time is simply not provided for that type search, to permit that determination. Claim 3 is not searchable in the time provided.

Claim 3 is not a Markush claim, see claim 1, and is a list of ultimate species. See the directive of Richard A Wahl, August 10, 1968, previously provided, and provided as Exhibit A.

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There is a different claim requirement in 37 CFR 1.141(a) for each ultimate species, as claim 3, here, avoids fees, the word “different” was added to stop abuse of the Rule 141.

In 1964 when I started, here, as an Examiner there was a 5 species requirement. That was changed to a reasonable number. Then the word “different” was inserted to specify that each species had to be a different claim, so the USPQ would not lose so much money on the claim.

Claim 3 is an aggravated, multiple page, example of listing ultimate species in one claim to avoid fees. 37 CFR 1.141(a) is said by *In re Fressola* to have the force of law, 22 USPQ 2d 1828.

The 1449 is ~~noted~~, but the scope of the claims cannot be determined at this time.

It cannot be determined how the species of claim 3 fall under claim 1. It is not known what is being claimed.

Note the repeated use of “substituted” in claim 1. Substituted with what? Applicants are requiring the reader to complete the claim.

The Supreme Court in 1928 in *Corona vs. Dovan* objected to the open breadth of “substituted” 1928 USSC, 1928 C.D. 253; 276 U.S. 358. The claim structure of claim 1 does not comply with 35 U.S.C. 112, 1st and 2nd paragraph. What is intended, where is it set forth in the specification?

Claims 6--9 violate 35 U.S.C. 101 and 35 U.S.C. 112, since they are drafted in terms of use. See *Clinical Products vs. Brenner*, 255 F. Supp. 151; 149 USPQ 475 (D.C. District Columbia 1966).

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Any claim, such as claim 5, that is/was not specifically rejected, is rejected as being dependent on a rejected claim. That is, the claim could not be allowed if written in independent form as it would contain rejected portions of the claim from which it depends.

John M. Ford:jmr

September 12, 2002

A large, stylized handwritten signature in black ink, appearing to read "J M Ford".

JOHN M. FORD  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Greg A. T.".